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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/736,032 | 12/13/2000 | James A. Savage | 0894.0010 | 6624 |

7590 12/16/2003

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| EXAMINER |
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DURAN, ARTHUR D

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,032

Applicant(s)

SAVAGE ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status25 MARCH 2002

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,11,12,15,16,18 and 19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,2,4-8,11,12,15,16,18 and 19 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 2, 4-8, 11, 12, 15, 16, 18, 19 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 5, 8, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037).

Claim 1, 2, 4, 5, 8, 11, 15, 19:

Reilly discloses a hand-held electronic device comprising:

a central processing unit;

random accessible memory; a viewing screen;

a motherboard; a modem;

data entry means (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67);

at least one advertisement, the at least one advertisement being viewable on the viewing screen,

the at least one advertisement being permanently stored on the device (col 3, lines 5-15).

Reilly further discloses that the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the

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product, video, animation, color, splash screen displayed in between a prescribing session, and company logo (Fig. 6; col 9, line 65-col 10, line 10; col 2, lines 4-25; col 13, lines 18-21); and, updating means for updating the at least one advertisement (col 3, lines 5-15).

Reilly further discloses updating the advertising via updating the software (col 5, lines 45-60; col 8, lines 5-10).

Reilly further discloses a signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

Reilly further discloses providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20);

Reilly does not explicitly disclose a hand-held device, printing information, or prescription writing means.

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Kolls further discloses audio, video, audio-visual (col 14, lines 50-55; col 33, lines 60-63) and coupon printing (col 17, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, and Kolls advertisement features to Reilly's remote computer with locally stored advertising that gets updated. One would have been motivated to do this because a PDA is a standard type of computer, prescription information is standard type of information stored on a computer, and

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printing information is a standard feature of computers with interfaces so that the user can receive a hard copy of the information viewed.

Claim 6: Reilly, Goetz, and Kolls disclose the method of claim 4, and Reilly further discloses that the method further comprises the step of:
updating the advertising via the signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

3. Claims 7, 12, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037) in view of Lupi (5,755,462).

Claim 7: Reilly, Goetz, and Kolls disclose the method of claim 4. Reilly does not explicitly disclose printing a prescription with the advertising on the prescription.

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising and information that gets updated. One would have been motivated to do this because printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Claim 12, 16: Reilly discloses a method, medium for advertising, the method comprising the steps of:

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providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20); and, providing at least one electronic advertisement on the device, the advertisement being permanently stored on the device (col 3, lines 5-15); transmitting information (col 3, lines 5-15).

Reilly further discloses updating the at least one advertisement (col 3, lines 5-15).

Reilly does not explicitly disclose a hand-held device, that the advertisements are banner advertisements or that the transmitted or printing information or that printed information is prescription information.

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Goetz further discloses advertising information (col 6, lines 64-66).

However, Kolls discloses that banner advertisements can be displayed on a PDA (col 3, lines 63-65; col 33, lines 60-65; col 34, lines 3-5) and that advertisement information and other information can be printed (col 35, lines 60-65).

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, Kolls' banner advertisements, and Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising that gets updated. One would have

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been motivated to do this because a PDA is a standard type of computer, prescription information is standard type of information stored on a computer, a banner is a standard type of electronic advertisement, and printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Claim 18: Reilly, Goetz, Kolls, and Lupi disclose the computer readable medium of claim 16, wherein providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, comprises:

providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, the device having a central processing unit, random accessible memory, a mother board, a signal converter, and data entry means ^{Reilly} (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/736,032

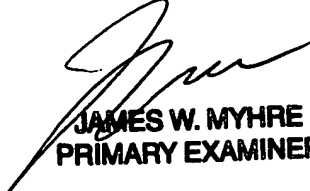
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

11//4/03


JAMES W. MYHRE
PRIMARY EXAMINER